REMARKS/ARGUMENTS

Claims 35-66 remain in the application for further prosecution. Claims 44 and 59 have been amended. Claims 1-34 and 67-68 were previously canceled. Claim 69 has been canceled without prejudice. In response to the Office Action mailed April 29, 2009, please consider the following remarks rendered in **appeal brief format**. The Examiner is invited to telephone the undersigned if the below remarks do not result in allowance of the claims, to discuss whether any agreement can be reached with respect to the claims to expedite prosecution and to avoid an appeal.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the Assignee, WMS Gaming, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in an appeal of this matter.

3. STATUS OF THE CLAIMS

Claims 35-66 remain in the application. Claims 1-34 and 67-68 have been canceled previously. Claim 69 is now cancelled.

4. STATUS OF AMENDMENTS

No amendments to claims 35-43, 45-58 and 60-66 have been made subsequent to the last amendment filed on February 13, 2009. Claims 44 and 59 are amended in this paper.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the present inventive subject matter include, but are not limited to, methods and systems for activation of different progressive awards via player-selection elements. The claimed subject matter is as follows:

35.   A method of playing a progressive game, comprising:

accepting a player wager at a gaming terminal of a plurality of gaming terminals, each of said plurality of gaming terminals being eligible for at least one progressive game payoff;

funding said progressive game payoff from a percentage of the player wagers, including said player wager, at said plurality of gaming terminals;

conducting a wagering game at via said gaming terminal;

achieving a progressive game entry award at said gaming terminal;

activating said progressive game in response to achieving said progressive game entry award;

displaying a plurality of player-selectable game elements during said progressive game including a first set of at least two elements associated with a progressive game payoff and a second, distinct set of elements, each being associated with a respective credit award;

selecting, via player inputs, at least one of said plurality of player-selectable game elements, said selecting includes sequentially selecting said player-selectable game elements;

awarding said progressive game payoff in response to said player selecting the first set of said player-selectable game elements; and

awarding the respective credit award in response to said player selecting at least one of said player-selectable game elements in said second, distinct set of elements, in addition to awarding said progressive-game payoff in response to said player selecting the first set of elements.

44.   A method of playing a progressive game at a gaming terminal, said progressive game having a first progressive game payoff and a second progressive game payoff, comprising:

accepting a player wager at a gaming terminal of a plurality of gaming terminals, each of said plurality of gaming terminals being eligible for said first and second progressive game payoffs;

funding said first and second progressive game payoffs from a percentage of the player wagers including said player wager, at said plurality of gaming terminals;

receiving, from said gaming terminal, at least one player input during said progressive game;

in response to said receiving said player inputs, determining whether said player input achieves said first progressive game payoff or said second progressive game payoff, said second progressive game payoff being greater than said first progressive game payoff, a first selection of player inputs yielding only said first progressive game payoff and a second selection of player inputs yielding only said second progressive game payoff, the second selection of player inputs differing from the first selection of player inputs; and

awarding to said player a corresponding one of said first and second progressive game payoffs.

54.   A method of playing a progressive game with a progressive game payoff, comprising:

accepting a player wager at a gaming terminal of a plurality of gaming terminals, each of said plurality of gaming terminals being eligible for at least said progressive game payoff;

funding said progressive game payoff from a percentage of the player wagers, including said player wager, at said plurality of gaming terminals;

conducting a wagering game at said gaming terminal;

simultaneously displaying a plurality of player-selectable elements corresponding to a plurality of possible player-selectable inputs;

receiving one of said plurality of player-selectable inputs, said plurality of player-selectable inputs including a concealed stop-game input and a concealed continue-game input with an associated credit award;

in response to receiving said concealed continue-game input, allowing a player to continue said progressive game and awarding the associated credit award, the credit award awarded in addition to any progressive game payoff;

in response to receiving said concealed stop-game input, ending said progressive game.

59.   A gaming terminal capable of playing a progressive game that is triggered during or after a wagering game being played at said gaming terminal, said progressive game having a first progressive game payoff and a second progressive game payoff that are funded by a percentage

of player-input wagers from said gaming terminal and other gaming terminals, said gaming terminal comprising:

> an input device for receiving inputs from a player during said wagering game, said inputs including a wager amount;

> a display for displaying a randomly selected outcome of said wagering game in response to receiving said wager amount from said player; and

> wherein, in response to said progressive game being triggered, said display displaying a plurality of player-selectable game elements, said progressive game awarding said first progressive game payoff or said second progressive game payoff based on a unique selection by said player of said player-selectable game elements associated only with the first or second progressive game payoff.

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Whether claims 35-48 and 52-65 should have been rejected as obvious over U.S. Patent No. 6,648,754 B2 ("Baerlocher") and U.S. Patent No. 6,241,608 ("Torango '608") and further in view of U.S. Patent Publication No. 2002/0042297 A1 ("Torango '297").

The Office Action rejected claims 35-48, 52-65 and 69 under 35 U.S.C. 103(a) as being unpatentable over Baerlocher and Torango '608 and further in view of Torango '297. Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher and Torango '608 and U.S. Patent No. 6,599,192 ("Baerlocher '192") and in view of U.S. Patent No. 5,275,400 ("Weingardt"). Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher and Torango '608, as applied to claims above, and further in view of U.S. Patent No. 6,224,484 B1 ("Okuda").

7.   **ARGUMENT**

A.   **Baerlocher Discloses A Fundamentally Different Game**

With regard to the independent claims, the Office Action has cited Baerlocher as disclosing "awarding the respective credit award in response to said player selecting at least one of said player-selectable game elements in said second, distinct set of elements, in addition to awarding said progressive-game payoff in response to said player selecting the first set of elements" citing Fig. 3, 5-6 and the related description. (pp. 2-3) The Office Action has conceded that Baerlocher does not disclose multiple progressive awards. However, the Office Action has cited Torango '608 as disclosing a progressive award and Torango '297 as disclosing qualifications for multiple progressive awards. (pp. 4-5).

Baerlocher is simply lacking basic elements of the claims not present in either Torango reference and therefore the combination of Baerlocher with the Torango references does not invalidate the claims at issue. Further, one of ordinary skill would not combine progressive games with Baerlocher given the inherent nature of the Baerlocher game.

Baerlocher is directed a singular gaming machine and not a plurality of game terminals that are necessary to contribute to progressive pools. Baerlocher relates to a game where a player selects one of a series of price tags 108a-x that conceal a number of steps as shown in Fig. 5. The price tags 108a-x do not conceal anything else other than the number of steps that a player may take on a scale of steps 110. Each price tag 108a-x selected allows a player to earn a greater award based on an offer of the increasing the steps on a scale of steps 110. The progression of the scale 110 is changed by the number of steps revealed in the selected price tag 108a-x. A player may stop the selections at any time to accept the award indicated on a scale of steps 110 or attempt to gain further steps for a greater award value. If the number of steps on the scale 110 is exceeded, the player receives a much smaller consolation award. Thus, the player

may only receive one award based on where on the series of steps in the scale 110 the player elects to stop or if the player exceeds the allowable number of steps. Any combination of selections may result in the proper number of steps on the scale 110, and therefore Baerlocher also does not disclose a specific set of elements associated with a credit award as the selections may result in no award at all.

B. **Claim 35 Is Allowable Over The Combination Of References**

1. **The Combination Of References Does Not Disclose Awarding A Progressive Award In Addition To A Credit Award**

Claim 35 requires that a player is awarded "the respective credit award in response to said player selecting at least one of said player-selectable game elements in said second, distinct set of elements, in addition to awarding said progressive-game payoff in response to said player selecting the first set of elements." Baerlocher only allows the awarding of a single award and therefore does not disclose awarding a credit award in addition to a progressive game payoff.

The Office Action has asserted that Baerlocher discloses if the player selects the accept button the award is credited to the player and if the player "still has enough 'offers' available then the player is provided with player selectable elements to try and win the progressive prize" citing Figs. 3, 5-6 and the related description. (p. 3).[1] Applicant respectfully disagrees with this characterization of Baerlocher. Nothing in these figures or the related description indicates that Baerlocher allows a player to use available offers to select additional elements to win an additional prize once the player has accepted a prize from the scale 110 in Fig. 5-6. As will be explained below, the assertion of the Office Action is directly contradicted by Baerlocher,

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[1] The undersigned has done an electronic word search through Baerlocher for the term "progressive" and the only two instances where that term appears are not descriptive of Figs. 3, 5 or 6.

violates the intent of the games disclosed in Baerlocher and the main embodiment in Baerlocher has no mechanism for using additional available offers.

Fig. 3 of Baerlocher describes a prior art picking game where a "player may accept or reject each offer prior to the final offer." (Col. 2, ll. 4-5). If the player accepts an offer, the offer is provided to the player and if the player rejects an offer, the gaming device provides another offer to the player. (Col. 2, ll. 5-8). The challenge of the game is the player choosing to take an immediate, known award or risk the known award for an uncertain, but potentially higher award. Nothing in this section or Fig. 3 indicates that once a player accepts an offer of the immediate award, they may continue to accept an additional offer. In fact, the interpretation that a player could continue to accept offers would destroy the point of the game as no player would ever reject an intermediate offer.

The embodiments shown in Figs. 5-6 of Baerlocher also only allow a player to win a single award once an offer is accepted, a player runs out of offers or when the player reaches the termination limit. (Col. 3, ll.1-12). The Office Action cannot cite any part of Baerlocher that teaches that if the player selects the stop button 106 in Figs. 5-6, they would be allowed to use the remaining number of offers. In fact, Baerlocher explains:

> It is therefore an advantage of the present invention to provide a gaming device with an offer and acceptance bonus game wherein <u>the game enables the player to obtain offers until the player accepts an offer</u>, meets or exceeds a termination limit or runs out of offers.

(Col. 3, ll. 42-45, emphasis added). The accepting of an offer terminates the game. Further, allowing the player to use additional offers once an offer is accepted would be contrary to the purpose of the game as Baerlocher explains:

> <u>The game also preferably provides a non-instantaneous or delayed reveal which adds excitement and enjoyment to the game. When the player rejects an offer, the game displays the steps accruing one at a time on an indicator in accordance with the theme of the game.</u> The player does not know when or where the accrual will stop. <u>The player</u>

hopes the indicator will designate a valuable offer and also hopes the indicator does not accrue steps that meet or alternatively exceed the termination limit. The improved delayed or non-instantaneous reveal provides more excitement and enjoyment than simply instantaneously revealing the accrued number of steps.

(Col. 2, ll. 29-40, emphasis added). Finally, Baerlocher does not disclose any mechanism by which a player may accumulate the credits with an offer and then continue to use remaining offers. The message 118 shown in Figs. 5-6 also does not disclose this possibility for a player. Baerlocher does not anticiapte claim 35 because the game in Baerlocher can only make one award.

2. The Combination Of References Do Not Disclose One Set Of Elements Associated With A Progressive Game Payoff And A Second Set of Elements Associated With A Credit Award

Claim 35 also requires that the "player-selectable game elements during said progressive game" include "a first set of at least two elements associated with a progressive game payoff and a second, distinct set of elements, each being associated with a respective credit award."

Baerlocher does not anticipate these elements because Baelocher does not allow a player to receive two different types of awards (the credit and the progressive awards in the claim). Players in Baerlocher only receive the single award based on the step on the scale 110 they decide to accept or a consolation prize if they exceed the steps in the scale 110. Once a player accepts an award, the game is concluded.

Baerlocher also does not disclose a first set of elements associated with a progressive award and a second set of distinct elements from the first set of elements, because all of the selectable elements in Baerlocher are added toward any number of awards. None of the selectable elements (price tags 108a-x) are associated with a single award. As explained above, Baerlocher only allows awarding one prize from the scale 110 while the elements 108a-x are associated with all of the prizes associated with the scale 110.

3. It Is Impermissible To Combine Baerlocher With Progressive Award Systems Such As Those Disclosed In The Torango References

Baerlocher would not be combined with progressive prize awards as those in Torango for numerous reasons. First, Baerlocher assumes the ability to select between multiple potential awards. As shown in Figs. 5A-5C, a player may be awarded one of a potential of nine different awards. Substituting a progressive award for each of these awards as suggested by the Office Action would be impractical because Baerlocher would require nine different progressive awards for each of the step levels in Figs. 5A-5C, each requiring a different pool of contributions and tracking mechanism for the award. Also, since progressive awards are variable, the use of progressive awards would distort the prize structure. For example, if each higher tier award in Baerlocher was a progressive award and the player accepted the offer such as step 122 in Fig. 5C, the value of that progressive award for that step 122 would drop to the reserve amount which may actually be lower than the unawarded progressive in a lower step (steps 11-14). This would defeat the purpose of the game as future players would have an incentive to take the higher reward at no risk rather than continuing to try for higher risk offers but lower rewards. One of ordinary skill would not combine Baerlocher with the concept of a progressive award in the Torango references.

C. Claim 54 Is Allowable

1. Claim 54 Requires Concealed Continue And Stop-Game Inputs

Claim 54 requires that a continue-game input with an associated credit award and a stop-game input are concealed from the player. Baerlocher does not disclose a concealed continue-game input with an associated credit award or a concealed stop game input. The Office Action has not indicated that Baerlocher discloses a concealed continue-game input or a concealed stop-

game input. As is clear from Fig. 6, the stop input 106 is not concealed in Baerlocher. The player selectable elements 108a-x in Figs. 4-6 of Baerlocher do not inherently have any associated award or stop the game as such actions depend on the previous selections in relation to the scale 110. To the extent that the selectable elements 108a-x in Baerlocher continue the game by allowing a player to proceed on the scale 110, they do not conceal an associated credit award as required by claim 54. Baerlocher also does not have a stop game input concealed from the player. In fact, the credit award varies depending on how many steps the player has previously accumulated on the scale 110. Thus, Baerlocher does not disclose these elements.

2. Baerlocher Does Not Disclose A Credit Award In Addition To A Progressive Award

Claim 54 also requires that the associated credit award be awarded to a player in addition to any progressive award if a continue-game input is selected and the game is terminated if the stop-game input is selected. Claim 54 is allowable because, as explained above, Baerlocher does not disclose awarding a credit award in addition to a progressive award. Baerlocher only awards one award based on the ultimate value of the steps on the scale 110 shown in Figs. 5-6.

D. Claims 44 And 59 Are Allowable

Amended claims 44 and 59 are also allowable over Baerlocher and the Torango references. Amended claim 44 requires "a first selection of player inputs yielding only said first progressive game payoff and a second selection of player inputs yielding only said second progressive game payoff, the second selection of player inputs differing from the first selection of player inputs." Similarly, amended claim 59 requires a "first progressive game payoff or said second progressive game payoff based on a unique selection by said player of said player-selectable game elements associated only with the first or second progressive game payoff." The Office Action has asserted that Baerlocher discloses a first game payoff and a greater second

game payoff based on player-selectable game elements. (p. 6). The Office Action has conceded that Baerlocher does not disclose a bonus payoff in the form of a progressive system but relies on Torango '297 as disclosing multiple progressive awards. Baerlocher does not disclose that the player-selectable game elements are uniquely associated with either a first or second award. The price tags 108a-x can be associated with any of the prizes on the scale 110. Baerlocher therefore does not disclose a first group of player selections only yielding one progressive award and a second group of player selections different from the first group of player selections only yielding a second progressive award.

Second, these claims require a first and a second progressive game payoff. As explained above, the combination of the Torango references and Baerlocher would not be considered by one of ordinary skill in the art because Baerlocher's game requires a constant scale of prizes that increase in value. The introduction of progressives would skew the fundamental principle of the Baerlocher game that gives the player an option to increase risk for higher reward. Further, paragraph 195 and Fig. 7 of Torango '297 do not disclose multiple progressive awards. At best, Fig. 7 relates to a free play that allows a player to select multiple prizes. There is no disclosure in Torango '297 of multiple progressive awards that can be awarded with different outcomes as required by these claims.

CONCLUSION

It is Applicant's belief that all of the claims are now in condition for allowance and actions towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

Date: June 25, 2009

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